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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,721	06/29/2000	Gordon C. Cheng	CC8128-DRIB	7493

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EXAMINER

WEBB, JAMISUE-A

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/606,721	CHENG ET AL. <i>CH</i>	
	Examiner	Art Unit	
	Jamisue A. Webb	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, 10, 11, 19, 22, 26, 35-38, 43, 45-49, 56, 79-85, 91-94 and 97 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 August 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> | 6) <input type="checkbox"/> Other: |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3,9,12,18, 20-21,23-25,27-34,39-42,44,50-55,57-78,86-90,95 and 96.

DETAILED ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 8/28/02 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of Figure 1 including reference numerals 341 and 350, Figures 2B including reference numeral 321. Although the specification gives descriptions for these reference numerals, they were never discussed in the specification with regards to Figures 1 or 2B.

Specification

2. The substitute specification submitted 8/28/02 has been accepted by the examiner.
3. The amendment filed 8/28/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the single component figures consisting of cellulose, the open-celled foamed polymers being polyvinyl alcohol foams and cellulose sponges, the fibrous mats of synthetic polymers being nylon, and sheets of flexible solid materials such as latex, and films of polyolefin (See specifically, Claim 7)

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7, 45, and 81 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See objection to specification above for new matter entered.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. With respect to Claim 35: The phrase "a hallow interior into which the penis is placed" is indefinite. This claims that the penis is placed in the means for conveyance, when clearly the drawings show that the penis is placed in the means for collecting. Is the system designed to be capable for the penis to extend entirely through the means for collecting, and into the means for conveyance?

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Claim Rejections - 35 USC § 101

9. Claim 19 is rejected under 35 U.S.C. 101 because there exists a positive recitation of a human and/or human anatomy as part of the claim invention. The phrase "further comprising a human male penis tip inserted into" claims the human male penis tip as part of the claimed invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 2, 4-8, 11, 26, 35-38 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Holland et al. (5,957,904).

12. With respect to Claim 1, 5, 6, 26, 35 and 38: Holland discloses the use of an external catheter, that is fully capable of being used by a male. Holland discloses a means for collection (11) (in which is also fully capable of receiving the male penis and using the straps to

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secure to the male penis), a means for conveying (24), a means for storage (31), and a means for wicking (30) which can be made from absorbent material that is fully capable of wicking fluid counter-gravitationally. As in Figure 2, if the means for collection was on it's side, then the wicking component would wick the fluid sideways, which is not under the influence of gravity, therefore counter-gravitationally.

13. With respect to Claim 2: Holland discloses a first connecting means (23) and a second collecting means (column 4, lines 15-19).

14. With respect to Claim 4: Holland discloses the wicking member extending into the collecting means and extending all the way through the conveying means and into the storage means (column 4, lines 15-31).

15. With respect to Claim 7, 36 and 37: See Column 5, lines 1-30.

16. With respect to Claim 8, 11, 26, and 43: Holland discloses the collection means to be a sheet of vinyl, which the examiner considers to be a thin wall. (column 3, lines 27-29)

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claims , 45, 48, 49, 56, 79-85, 91-94 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (6,068,618) in view of Holland (5,957,904).

20. With respect to Claims 1, 45, 56, 79, 82-85, 91-94 and 97: Anderson discloses a male urinary system (20), with a means for collecting urine (24), a means for storage of urine (50), and a means for conveying urine from the collection means to the storage means (52). Anderson however fails to disclose a means for wicking urine away from the male genitals counter-gravitationally.

21. Holland discloses the use of a urinary system that is attached to the human body, and has a wicking system (30) that extends from the collection means, through a conveyance means and into a storage means (see Figures 1 and 2, and Column 4, lines 32-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the male urinary system of Anderson, contain the wicking member of Holland, in order to aid in the transport fluid from the collection pouch to the storage container. (see Holland, Column 4).

22. With respect to Claim 2: Anderson discloses a first connecting means (54) and a second collecting means (56).

23. With respect to Claims 8, 10, and 46, 47: Anderson discloses a radial compression tube (30).

24. With respect to Claims 48 and 80: See Anderson, column 3, lines 20-47.

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25. With respect to Claims 49 and 81: See Holland, column 5, lines 1-30.

Response to Amendment

26. The amendment filed 8/28/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: See above in the objection to the specification for the specific limitations which are considered new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

27. It should be noted that applicant has added a new claim in which it was labeled 95. The claim has been relabeled as Claim 97, due to the fact that Claims 95 and 96 exist in the case, but are withdrawn from consideration due to them being drawn to an unselected species.

Allowable Subject Matter

28. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

29. Applicant's arguments filed 8/28/02 with regards to the election requirement have been fully considered but they are not persuasive.

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30. Applicant has argued the election requirement to certain claims. Based on the fact that the drawings were now amended to include the species that was not considered earlier. However as noted above, the drawing changes are not accepted by the examiner due to the fact that it brings new matter into the case. For instance, the applicant has added reference numeral 350 to point to a previously unlabeled item in Figure 1. And where as the specification does talk about other embodiments having absorbent material 350, the specification does not refer to 350 with regards to Figure 1, nor does it disclose figure 1 having absorbent material. Therefore election stands as in the last office action.

31. Applicant's arguments with respect to the prior art rejections of the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jaw 
November 30, 2002


DENNIS RUHL
PRIMARY EXAMINER